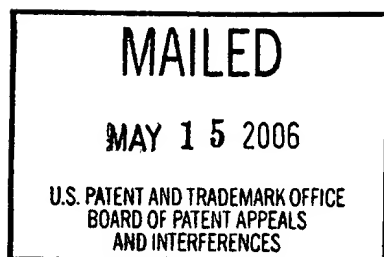


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte G. VICTOR TREYZ and SUSAN M. TREYZ



Appeal No. 2006-1044
Application No. 09/365,651

ON BRIEF

Before: OWENS, LEVY and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 21 through 40. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a system in which a customer may view images taken by a photographer and order products or services related to the images.

See page 2 of appellants' specification.

Claim 21 is representative of the invention and is reproduced below:

21. Order servicing equipment for an on-line system that allows a user to order image-based products over the Internet, comprising:
at least one order servicing computer that receives an uploaded digital image over the Internet; and
digital printing equipment, wherein the order servicing computer is configured to present the user with an opportunity to view the uploaded digital image on-line over the Internet, wherein the order servicing computer is configured to provide the user with an opportunity to edit the uploaded digital image on-line over the Internet, wherein the digital printing equipment is configured to print the edited digital image to create a print for framing, and wherein the order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print.

References

The references relied upon by the examiner are:

Nozaki et al. (Nozaki)	6,349,194	Feb. 19, 2002 (filed May 04, 1999)
Bruck et al. (Bruck)	6,008,836	Dec. 28, 1999
Oberg	5,870,771	Feb. 09, 1999
Plettinck et al. (Plettinck)	5,689,349	Nov. 18, 1997

Melissa A. Weisman (Weisman), "Internet wedding albums reach far-flung relatives" The Patriot Ledger, Oct. 21, 1998.

Rejections at Issue

Claims 21 and 23 through 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oberg in view of Nozaki. Claims 31 through 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oberg in view of Nozaki and Weisman. Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Oberg in view of Nozaki and Plettinck. Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Oberg in view of Nozaki and Bruck.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejections of claims 38 and 40 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejections of claims 21 through 37, and 39 under 35 U.S.C. § 103.

Claims 21 thorough 32.

On pages 15 and 16 of the brief, appellants assert claim 21 recites ordering servicing equipment that receives uploaded digital images over the Internet, allows a user to edit the image, and select a frame for the image. The order servicing equipment also includes a printer to create a print of the digital image for framing. Appellants argue, on page 16 of the brief, that Oberg does not teach these features. Appellants reason that Oberg teaches a system to help users select frames for artwork. Appellants argue on page 17 of the brief, that Oberg's system does not have the hardware and software to produce prints to be framed as the user already has the art work to be framed, rather the printers in Oberg produce confirmation copy of the user's order.

In response the examiner states, on pages 16 and 17 of the answer:

Oberg's system is capable to perform that task, a printer in Oberg's system would perform the same task as in claim 21. It is not inventive to have a system being able to generate a print (for framing) (this is old and well known step even with Kodak's or Fuji's articles that the applicants submitted for consideration). This above rationale would answer applicants' augment on page 4, para.1. It is true that Oberg's system does not expressly say the same claimed language as in the application; but this is an obvious rejection; Oberg's system is obvious in generating a prints [sic] (see Oberg, 4:41-50). In contrast to the argument on page 5, para. 1, the examiner submits that Oberg's system is able to use [sic, be used] for ordering a frame (claiming that framing a picture wherein that picture is printed out from a computer is not an inventive concept (see claim 21: "wherein the order servicing computer is configured to present the user with an opportunity to select a given type of frame for the "print").

We concur with the appellants. Initially we note that the examiner rejected claim 21 under Oberg in view of Nozaki as set forth on pages 4 and 5 of the answer. The examiner's stated rejection does not rely upon either the Kodak or Fuji article nor does it present evidence as to why one would be motivated to modify Oberg and Nozaki to include the teachings of the Kodak or Fuji article. Thus, the rejection before us is not whether claim 21 is unpatentable over Oberg and Nozaki and either the Kodak or Fuji article. Because the Kodak and Fuji article are not cited in the statement of the rejection they have not been considered.

The rejection as presented in the final rejection dated August 25, 2003 and reiterated on pages 4 and 5 of the answer relies upon Oberg and Nozaki. We find that Oberg teaches a system whereby a user can load digital images of artwork to be framed. The image is analyzed and suggestions concerning matting and framing are made. The system provides a visualization of what the artwork will look like framed so that the user may preview the framed artwork before placing an order. See column 3, lines 25 through 32. Oberg teaches that the system may be used over the Internet so that customers may make their selections from home. See column 7, lines 23 through 25. Further, Oberg discloses that the user can create a composite image of the artwork, mating and framing. See column 6, lines 36 through 62. The user can print out a copy of the

order including an image of the order. See column 7, lines 9 through 13. While the composite image does represent an edited digital image, we do not consider the printing of this image to be a print of the digital image for framing as claimed. The examiner does not assert that Nozaki teaches a printer to print the digital image submitted over the Internet as claimed. Claims 22 through 32 are dependent upon claim 21. With regard to claims 22 which is rejected over Oberg, Nozaki in view of Plettinck and claim 26 which is rejected over Oberg, Nozaki in view of Bruck, the examiner does not assert that Plettinck or Bruck make up for the noted deficiency in Oberg. Accordingly, we will not sustain the examiner's rejection of claims 21 through 32 as being unpatentable over Oberg and Nozaki.

Claims 33 through 37.

Appellants assert, on page 23 of the brief, that independent claim 33 relates to event photography where an ordering servicing computer is provided with a customer list and uses an assignment title to identify an event. The customer list and assignment title are used to provide customers with an opportunity to select an event and order prints of the images from the event. Appellants argue, on pages 23 and 24 of the brief, that Oberg, Weisman and Nozaki do not teach these features. Further, appellants argue that just because customer lists and titles are old and well known does not make the system of independent claim 33 obvious.

On page 14 of the answer, the examiner, responds to the appellants' arguments directed to the claims 33, 35 through 37 and 40. However, the

examiner does not directly address appellants' arguments directed to the limitations of claim 33.

We find appellants' arguments directed to claim 33 to be persuasive.

Claim 33 recites:

33. Order servicing equipment that allows customers to place on-line orders for prints of digital images taken by a photographer at an event comprising:

at least one order servicing computer, wherein the order servicing computer is provided with the digital images taken by the photographer and is provided with customer information including a customer list that includes names of the customers for the event, wherein the order servicing computer uses an assignment title to identify the event, wherein the order servicing computer is configured to provide the customers with an online opportunity to select the given event from a list of events, wherein in at least some of the digital images a customer in the customer list is a subject of the digital image, wherein the order servicing computer is configured to use the customer information in providing each of the customers with an opportunity to place an on-line order for a print of at least one of the digital images to be mailed to the customer.

As stated *infra* with respect to claim 38, we find that Weisman teaches a system where a user can, over the Internet, order pictures taken at an event by a photographer and implicit to Weisman is that the address of the web site is information concerning the customer or event. However, claim 33 recites two types of information associated with the pictures; an assignment title, which identifies the event and a customer list. While the web page address may be an

analog to either one of these types of information it is not an analog to both. We do not find that Oberg or Nozaki teach or suggest use of either customer list or assignment title in conjunction with a system for a user to order, on-line, prints of pictures taken by a photographer at an event. Accordingly, we will not sustain the examiner's rejection of claim 33 or the claims dependent thereon, claims 34 through 37.

Claims 38 and 40

Appellants argue, on pages 25 and 26 of the brief and pages 14 and 15 of the reply brief, that claim 38 relates to ordering wood or metal framed prints of images taken by a photographer at an event and is a feature that neither Oberg, Weisman nor Nozaki teach.

We are not persuaded by appellants' arguments. Claim 38 recites:

38. Order servicing equipment that allows customers to place on-line orders for prints of digital pictures taken by a photographer at an event, wherein at least some of the digital images include the customers, comprising:

at least one order servicing computer, wherein the order servicing computer is provided with the digital images taken by the photographer and is provided with customer information identifying at least some of the customer [sic] in the digital images, wherein the order servicing computer is configured to allow customers to view the digital images over the internet using a web browser, wherein the order servicing computer is configured to provide the customers with opportunities to order wood and metal framed prints of the digital images over the Internet.

The examiner finds, on page 8 of the answer, that Weisman teaches an order servicing computer to provide a user with an opportunity to order a print of a digital image that includes the user as the subject. We concur. Weisman

teaches a system whereby event photographers of an event, such as a wedding, can post their pictures on private pages of a web site. Though not expressly stated, one skilled in the art would recognize that the private pages of Weisman have an address associated therewith, that users access to the web site is through the Internet, and view the web pages with a browser. Access to the web pages is also controlled by a password. We consider the address and password to meet the claimed "information identifying at least some of the customers in the digital images." Weisman identifies that users can order prints of the digital images from the web page.

The examiner finds on page 5 of the answer, that Oberg teaches a system that allows a user to visualize the framing and matting of a piece of artwork. As stated *supra*, we find that Oberg teaches a system whereby a user can load digital images of artwork to be framed. Oberg teaches that the system may be used over the Internet so that customers may make their selections from home. See column 7, lines 23 through 25. Oberg also teaches that the system is envisioned to be used by professional photographers to show their customers digital images of the photographs taken and to suggest various frames and matting materials. See column 7, lines 29 through 33. Oberg does not state that the frames may be wood or metal. However the examiner has taken official notice of the existence of wood or metal frames at the time of the invention and

the appellant has not challenged these facts. One skilled in the art viewing Weisman's disclosure which allows a professional photographer to obtain a Internet forum for images taken at an event and Oberg's disclosure of providing an Internet system for previewing framed digital photographic images would have recognized the benefit of combining the two teachings such that Weisman's system could be used to order prints of the event in frames selected by the user.

Accordingly, appellants have not convinced us of an error in the examiner's rejection of claim 38 and we will sustain the examiner's rejection of claim 38.

On page 24 of the brief, appellants group claim 40, stating "[c]laims 35-37 and 40 depend upon from claim 33 and are patentable because claim 33 is patentable." However, claim 40 is dependent upon claim 38 not claim 33 as asserted in appellants' arguments. Appellants have presented no arguments as to why claim 40 is separately patentable from claim 38 upon which it depends. Accordingly, we will sustain the examiner's rejection of claim 40 for the reasons stated with respect to claim 38.

Claim 39

Appellants assert, on page 25 of the brief, that claim 39 is directed to arrangements wherein the customer was photographed against a solid color background and the resulting digital image is manipulated to replace the solid color background with a new background. Appellants argue that Oberg,

Weisman and Nozaki do not teach this feature. Further, appellants argue that “[t]he ‘backgrounds’ of Weisman that were relied upon in rejecting these claims are just the colors of the web pages on which the Memories Online website displays images.”

The examiner responds on page 15 of the answer, asserting that Weisman teaches that the order servicing computer provides the user with the opportunity to order a print that includes a background different than the background against which the user was originally photographed.

We concur with the appellants and find that the examiner has misconstrued the teaching of Weisman. Weisman states, on page 2 of the article: “At another, Memories Online (www.memoriesonline.com), clients can personalize their album by clicking the computer mouse to select background color, viewing order of pictures and to incorporate music, sound effects, title the album and write captions.” Thus, the changing of backgrounds discussed in Weisman is the background of the album, (webpage) and not the background of the picture. Accordingly, we will not sustain the examiner’s rejection of claim 39.

Conclusion

In summary, we have sustained the examiner's rejections of claims 38 and 40 under 35 U.S.C. § 103. However, we have not sustained the examiner's rejections of claims 21 through 37 and 39 under 35 U.S.C. § 103.

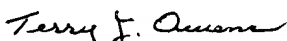


Observations and Remarks

As discussed, *supra*, we have not considered the Kodak or Fuji articles because they are not formally listed in the statement of the rejection. We leave it to the examiner to determine if any or all of claims 21 through 37 and 39 should be rejected over the Kodak and/or Fuji articles in combination with any other prior art.

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No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

		
TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
STUART S. LEVY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
ROBERT E. NAPPI)	
Administrative Patent Judge)	

REN/vsh

Appeal No. 2006-1044
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